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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/057,237	01/24/2002	Edward R. Hyde JR.	10254-006-999	3136

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Pennie & Edmonds, LLP
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Palo Alto, CA 94304

EXAMINER

ROBERT, EDUARDO C

ART UNIT	PAPER NUMBER
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3732

8

DATE MAILED: 11/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/057,237

Applicant(s)

HYDE, EDWARD R.

Examiner

Eduardo C. Robert

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) 20,32-41 and 49-54 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19,21-23 and 42-48 is/are rejected.
- 7) ☒ Claim(s) 24-31 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 April 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3,5.
- 4) ☒ Interview Summary (PTO-413) Paper No(s). 8.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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DETAILED ACTION***Election/Restrictions***

Applicant's election with traverse of Invention I, i.e. claims 1-31 and 42-48, and Species III, i.e. Figure 25, in Paper No. 7 is acknowledged. It is noted that the examiner contacted applicant's representative, i.e. Mr. Thomas D. Kohler, to clarify that Invention I includes claims 42-48 and not 32-41 as stated in the restriction requirement. Mr. Kohler agreed with the clarification. The traversal is on the ground(s) that claim 1 is generic. This is not found persuasive because claim 1 does not read on the Species II, i.e. Figure 20. Figure 20 does not have an assembly comprising at least first and second modules wherein the first module provide a portion of a uniform articular surface and the second module provide a portion of the uniform articular surface. It is noted that this claim 1 is directed to a modular head piece (see for example applicant's specification page 30, lines 20-25) and in the Species II, i.e. Figure 20, the head piece 183 is not modular.

It is acknowledged that applicant believes claims 1-19, 21-31 and 42-48 read on the elected Species. The examiner agrees with applicant.

Claims 20, 32-41, and 49-54 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected Invention and/or Species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No.7.

The requirement is still deemed proper and is therefore made FINAL.

Specification

The abstract of the disclosure is objected to because it contains language that can be implied, e.g. "The present invention relates to". Correction is required. See MPEP § 608.01(b).

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. **It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.**

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2-19, 21-23, and 42-48 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 2, line 7, "the assembly head piece" lacks a prior antecedent.

In claim 10, line 10, "the first attachment component" is indefinite because it is unclear to which of the first attachment component applicant is referring to, e.g. the attachment component of the terminal stem module or of the extender module. Also, in line 10, the recitation of "complementary attachment component" is indefinite because it is unclear to which of the complementary attachment components applicant is referring to, e.g. the one from the extender

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module or from the proximal stem module. Also, in line 11, the recitation "two modules" is indefinite because it is unclear to which of the modules applicant is referring to.

In claim 42, lines 5 and 8, respectively, "the assembly head piece" and "the prosthetic head assembly" each lacks a prior antecedent.

In claim 44, line 1, "said cap shaft" lacks a prior antecedent.

In claim 45, line 3, "cap stem" lacks a prior antecedent.

In claim 47, line 1, "the body" lacks a prior antecedent. In line 3, "the collar module" is indefinite because it is unclear to which of the collar module applicant is referring to.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 1 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 55 of copending Application No. 10/147,676. Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference between the application claim and the application '676 claim lies in the fact that the application '676 claim includes more elements and are thus much

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specific. Thus the invention of the application '676 claim is in effect a "species" of the "generic" invention of the application claims. It has been held that the generic invention is "anticipated" by the "species". See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993). Since the application claim is anticipated by the application '676 claim, it is not patentably distinct from the application '676 claim.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim 1 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 55 of copending Application No. 10/147,674. Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference between the application claim and the application '674 claim lies in the fact that the application '674 claim includes more elements and are thus much specific. Thus the invention of the application '674 claim is in effect a "species" of the "generic" invention of the application claims. It has been held that the generic invention is "anticipated" by the "species". See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993). Since the application claim is anticipated by the application '674 claim, it is not patentably distinct from the application '674 claim.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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Allowable Subject Matter

Claims 2-19 and 21-23 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Claims 24-31 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 42-48 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

Conclusion

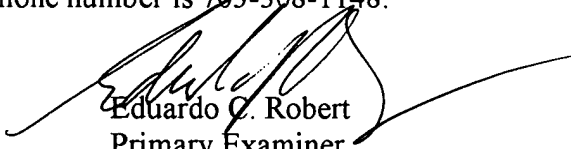
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892 for art cited of interest.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eduardo C. Robert whose telephone number is 703-305-7333. The examiner can normally be reached on Monday-Friday, 9:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin P. Shaver can be reached on 703-308-2582. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.



Eduardo C. Robert
Primary Examiner
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E.C.R.